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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,967	08/10/2000	Robert J. Klein	47171-00272	6269

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01/17/2002

EXAMINER

SHAPIRO, JEFFERY A

ART UNIT

PAPER NUMBER

3651

DATE MAILED: 01/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED
JAN 22 2002
RESP. 1st CA 4/17/02
Deadline 7/17/02

Office Action Summary

Application No.

09/635,967

Applicant(s)

KLEIN ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 157, 158 and 165-189 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 157, 158 and 165-189 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 7. 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 157 is rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto 4,653,647. Notice operation section 1 which is for designating an operation mode by which an operator designates which pocket 5, 6 or 7 the various notes are sent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 164-189 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto 4,653,647 in view of Cargill et al 5,430,664. Hashimoto discloses all of the features of the applicant's claimed invention. Note that per the abstract of Hashimoto, for example, when a first pocket is filled with currency notes, the transport path is automatically switched to a second pocket. Note also figure 3, which shows human interface with the device of Hashimoto.

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Cargill et al discloses particulars of control circuitry for allowing error detection and operator control.

Both Hashimoto and Cargill et al are analogous art as they both concern bill counting and sorting apparatus.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have used the control particulars of Cargill et al in the bill sorting and stacking apparatus of Hashimoto.

The suggestion/motivation for doing so would have been to provide digital control networking capability to "coordinate operations of counting and verifying documents". See abstract of Cargill et al.

Therefore, it would have been obvious to combine Hashimoto and Cargill et al.

Claims 157, 158 and 164-189 are rejected under 35 U.S.C. 103(a) as being unpatentable over Omatu et al 5,729,623 in view of Molbak et al. Omatu et al discloses a bill sorter with neural network and artificially intelligent decision making capability in a bill sorter having two output receptacles, which necessarily has a human interface.

Molbak et al discloses particulars of operator interface and allowing error detection and operator control (operator intervention). See figures 2, 4 and 5.

Both Omatu et al and Molbak et al are analogous art as they both concern currency counting and sorting apparatus.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have used the operator intervention particulars of Molbak et al in the bill sorting and stacking apparatus of Omatu et al.

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The suggestion/motivation for doing so would have been to provide user control over the sorting process. See col. 2, lines 15-22 of Molbak et al.

Therefore, it would have been obvious to combine Omatu et al and Molbak et al.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 157, 158 and 164-189 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-56 of U.S. Patent No. 6,311,819 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '819 patent disclose and describe the multiple output receptacles and operator interface of Applicants' claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Martin et al, Eglise et al and Bittner et al are cited as examples of currency sorting and handling machines.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher P. Ellis can be reached on (703)308-2560. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-0552 for regular communications and (703)308-0552 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Jeffrey A. Shapiro
Patent Examiner,
Art Unit 3651

January 14, 2002